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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,469	03/26/2004	Joan Vermeersch	227964	3990

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EXAMINER

LEE, SIN J

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,469

Applicant(s)

VERMEERSCH ET AL.

Examiner

Sin J. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verschueren et al (EP 0 950 516 A1).

Verschueren teaches ([0026] a heat mode imaging element (for making a lithographic printing plate) having on a lithographic *base with a hydrophilic surface* a first layer including an *aqueous alkaline solution-soluble polymer* and a top layer, which is IR sensitive and *unpenetrable for an alkaline developer* and which also contains a compound that increases the dynamic friction coefficient of the top layer to 0.40-0.80 (it is to be noted that present specification, pg.8 states that the present coating can be

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composed of two or more separately coated layers). As one of the examples for the latter compound, Verschueren teaches ([0029]) *water insoluble* inorganic compound having particle size of 0.3-50 um and having a *three-dimensional structure* with *siloxane bonds* extending three-dimensionally and with silicon atoms bonded to one organic group such as *methyl group*. Since the range of 0.3-50 um overlaps with present range of 1-7 um of claims 1, 10 and 11, the prior art's teaching would render present range *prima facie* obvious. In the case "where the [claimed] ranges overlap or lie inside ranges disclosed by the prior art," a *prima facie* case of obviousness would exist which may be overcome by a showing of unexpected results, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Therefore, Verschueren render obvious present spacer particles (which are crosslinked poly alkylsiloxane). Since Verschueren's top layer is unpenetrable for an alkaline developer, it is the Examiner's position that it is impliedly taught that the top layer contains presently claimed developer resistance means. Verschueren's top layer comprises an IR dye or pigment (see [0031]). Therefore, the prior art teaches present infrared light absorbing agent. In [0038], Verschueren teaches a novolac polymer as one of a few examples for the alkali soluble, hydrophobic binders used in Verschueren's first layer. Therefore, the prior art teaches present oleophilic resin soluble in an aqueous alkaline developer. Therefore, the prior art's teaching would render obvious present coating of claim 1 and thus present inventions of claims 1, 3, 5 and 10-12 (it is the Examiner's position that Verschueren's *water insoluble* inorganic compound having a three-dimensional structure with *siloxane bonds* extending three-dimensionally and with silicon atoms bonded to one organic group such

as *methyl group* would inherently be capable of improving the scuff-mark resistance of the coating as presently recited in claims 10 and 11).

With respect to present claim 4, Verschueren teaches ([0034] and [0041]) that the total amount of his top layer ranges from 0.05-10 g/m² and that the total amount of his first layer ranges from 0.1 to 10 g/m², thus giving 0.15-20 g/m² in total. Since the latter range overlaps with present range of 0.6-2.8 g/m², the prior art's teaching would render present range *prima facie* obvious. In re Wertheim, supra. Therefore, the prior art's teaching renders obvious present invention of claim 4.

With respect to present claim 6, Verschueren teaches the amount of his compound that increases the dynamic friction coefficient of the top layer to be 20-400 mg/m² preferably (see [0029]). Since this range overlaps with present range of 5-200 mg/m², the prior art's teaching would render present range *prima facie* obvious. In re Wertheim, supra. Therefore, the prior art's teaching renders obvious present invention of claim 6.

With respect to present claim 7, since Verschueren's compound that increases the dynamic friction coefficient of the top layer contains a *three-dimensional structure* with *siloxane bonds* extending three-dimensionally and with silicon atoms bonded to one organic group such as *methyl group* (i.e., the compound contains crosslinked polymethylsiloxane units), it is the Examiner's position that Verschueren's compound would inherently act as present developer resistance means. Therefore, Verschueren's teaching renders obvious present invention of claim 7.

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verschueren et al (EP 0 950 516 A1) in view of applicants' admitted prior art (pg.4, lines 31-33).

Applicants state (pg.4, lines 31-33) that it is a typical industrial process that after coating and drying, the lithographic thermal printing plate materials are stacked with or without an interleave in between the plates and that those plates are handled in packaging equipment for cutting and packaging. Therefore, it is the Examiner's position that Verschueren in view of applicants' admitted prior art renders obvious present inventions of claims 8 and 9.

Response to Arguments

5. Applicants argue that the data set forth in the specification does establish unexpected superior results associated with the claimed particle size range of 1-7 μm . However, the four rating-level system employed in present comparison seems relative and subjective. *For example*, there is no clear standard that explains how the result is determined to be "3" (which applicants call as "still acceptable for a printing plate" as opposed to "4" (which applicants call "unacceptable for a printing plate application"). That is, there is no numerical data or pictures (that distinguishes differences between "1", "2", "3" and "4") presented in present comparison.

Applicants also argue that their unexpected superior results of the preset invention are demonstrated by the entire set of the examples. However, MPEP 716.02(d) states that the showing of *unexpected results* must be reviewed to see if the results

occur over the *entire claimed range* (which would include present particle size of 6 or 7 μm). See also In re Peterson, 315 F.3d 1325, 1329-31, 65 USPQ2d 1379, 1382-85 (Fed. Cir. 2003) (data showing improved alloy strength with the addition of 2% rhenium did not evidence unexpected results for the entire claimed range of about 1-3% rhenium). Also, in order to demonstrate criticality of a claimed range, applicants should compare *a sufficient number of tests both inside and outside* the claimed range. In re Hill, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). The only number outside of present range shown by applicants is 0.5 μm (plus, applicants have not shown any number higher than 7 μm).

For the reasons set forth above, present rejections still stand.

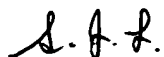
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

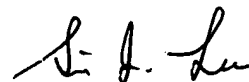
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
September 18, 2006



SIN LEE
PRIMARY EXAMINER